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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,378	02/10/2005	Timothy J. Philpot	GB02 0130 US	4848
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EXAMINER SILBERMANN, JOANNE				
ART UNIT 3611		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,378

**Applicant(s)**

PHILPOT, TIMOTHY J.

**Examiner**

Joanne Silbermann

**Art Unit**

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the holder in which a computer readable storage medium can be encased (claim 10) and first and second gaps between the pairs of lips (claims 22 and 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the pairs of lips being separated around the opening by first and second gaps between the pairs.

***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 26-30 should be renumbered 25-29. The following claims rejections are made based on such renumbering.

4. Claim 13 is objected to because of the following informalities: the phrase "to which a computer readable storage medium" has been inserted twice. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The use of "standard" in the claims is considered to be indefinite since this does not adequately describe and particular size or shape.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 10, 13-15, 18, 19, 25, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Perego, EP 1,083,563 A1.

10. Perego discloses holder 2 to which computer readable storage medium can be detachably attached or encased (as best as can be understood from the instant Drawings), The holder having a planar shape (Figure 1) and a size corresponding to a conventional credit card (column 2 lines 44-46). Based on the size of the storage medium shown (in Figures 4 and 5 for example) the length of the holder is at least 100% greater than the width of the storage medium, as best as the claims can be understood.

11. Regarding claim 15, Perego discloses more than one storage medium on one card (column 5 lines 56-58).

12. Regarding claims 18 and 19, Perego discloses a holder (Figure 4) having an opening the same size as a storage medium 7, the holder including deformable accommodation means 14. Accommodation means 14 include at least one protrusion 14a.

13. Regarding claim 25, the holder is suitable for storage in a wallet.
14. Claims 10 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmer et al. US #2,910,793.
15. Helmer et al. disclose holder "A" having a planar shape into which a computer readable storage medium may be attached or encased (Figure 2). The holder defines an opening (Figure 2) and comprises deformable accommodation means, or lips, 10b and 10c (Figure 5) for deforming upon insertion and removal of the displayed object. Each side includes a pair of such lips, one of which is longer than the other (Figure 5). A gap is formed between these lips on each side of the holder. A center of the holder is the bendable region. Neither planar face of an attached or encased object is entirely covered when held in the holder.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 11, 12, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego.
18. Perego does not teach the specific dimensions of the holder, however as best as the claims can be understood, the size of a conventional (as taught by Perego) credit card is 54 mm by 85 mm and a thickness of less than 5 mm.

19. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego in view of Walker, US #5,533,614.
20. Perego does not teach how the memory units are assembled on the card, however Walker teaches optically read discs attached side-by-side on the same side of a holder. It would have been obvious to one of ordinary skill in the art to attach discs to the holder of Perego in the manner taught by Walker so that more than one disc may be seen at the same time.
21. Regarding claim 17, the holder is "adapted to hold" two small form factor optical discs.

***Allowable Subject Matter***

22. Claim 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
23. The following is a statement of reasons for the indication of allowable subject matter: A planar holder having first and second openings for holding storage media such that the planar faces of the media are not entirely covered when in the holder, and each opening including first and second pairs of lips opposing each other across respective openings and being separated around the respective openings by gaps between the pairs wherein the gaps also opposing each other across the opening and further including a bendable region of the holder extending along a bending axis passing through at least one of the first gaps, the opening, and the second gaps and

forming an accommodations means for the storage media is not shown nor suggested by the prior art of record.

***Response to Arguments***

24. Applicant's arguments filed July 7, 2008 have been fully considered but they are not persuasive.

25. Applicant argues that the word "standard" in the claims is definite because she has never seen business cards or credit cards of different shapes and sizes and because if the size or shape of such cards should change, the holder of the invention would then change to whatever size is considered to be standard. As previously stated by the examiner, claim language must be precise and definite, not changing. Credit cards and business cards come in many sizes and shapes and even though one particular size and shape may be most popular this does not make the claim definite.

26. Regarding claim 10, Applicant argues that Helmer does not teach using the holder for computer readable media, however this is considered to be intended use and is not given weight in an article claim.

27. Regarding claim 15, the claim requires only that a second storage media "can be" detachably attached thereto. No storage media is definitely claimed.

28. Regarding claim 18, Applicant defines the opening in terms of a storage medium which is not part of the claimed invention. The opening shown in Perego is the same size as a storage medium.

29. Regarding claim 22, in the Helmer reference each side of the holder 10, 12 includes a pair of lips which are separated by the cross pieces 14, 16.



30. Regarding the use of the Walker reference, this reference was cited to show a holder for retaining more than one optical disc in a side by side relation. As stated in the rejection, it would have been obvious to one of ordinary skill to utilize this teaching in the holder of Perego to retain more than one disc.

31. Regarding new claim 26, the use of such a holder in a wallet is made possible by using a wallet of sufficient size to retain the holder. No particular size of the wallet has been claimed. The examiner also makes note of CD wallets which are large enough to hold CDs and DVDs and are still called wallets.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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